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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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| Proceeding | 92053355 |
| Party | Defendant Wyman Von Mohr & Associates |
| Correspondence Address | EDWARD M. WEISZ COZEN O'CONNOR 277 PARK AVENUE NEW YORK, NY 10172 UNITED STATES ipdocketing@cozen.com |
| Submission | Motion to Compel Discovery |
| Filer's Name | Lisa A. Ferrari |
| Filer's e-mail | lferrari@cozen.com, rwalker@walkermckenzie.com |
| Signature | /Lisa A. Ferrari/ |
| Date | 04/05/2012 |
| Attachments | Wyman Memo of Law.pdf (8 pages)(264442 bytes) |

UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

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| STRIKE KING LURE COMPANY, | : | |
| | : | |
| Petitioner, | : | Cancellation No. 92,053,355 |
| | : | |
| vs. | : | |
| | : | |
| WYMAN VON MOHR & ASSOCIATES, | : | |
| | : | |
| Registrant. | : | |

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**MEMORANDUM OF LAW IN SUPPORT OF
REGISTRANT’S MOTION TO COMPEL DISCOVERY
AND PRETRIAL DISCLOSURES**

This Memorandum Of Law is filed in support of Registrant’s motion to compel the production of documents, responses to Interrogatories, and pretrial disclosures of Petitioner Strike King Lure Company (“Petitioner” or “Strike King”) in Cancellation Proceeding No. 92,053, 355.

As set forth herein, Petitioner has utterly failed to prosecute this action, failing to serve Initial Disclosures, arrange an initial discovery conference, or serve expert disclosures, discovery requests, or pretrial disclosures. On February 6, 2012, Wyman served requests for production and Interrogatories on Petitioner. *See* Declaration of Lisa A. Ferrari (“Ferrari Dec.”), Exhibits A, B. Objections and responses were due March 12, 2012. Although in response to letters and email, Strike King eventually promised to serve its documents and responses by April 5, 2012, Strike King had yet to serve anything at the close of business on that date. Moreover, it is unclear whether Strike King intends to object to Registrant’s discovery requests on the merits, which its untimely responses would not allow it to do in any event.

Registrant therefore brings this motion to preserve its rights, and seeks an Order compelling Strike King to produce the documents and information, without objections, and serve pretrial disclosures by a date certain. Moreover, in view of Petitioner's failure to prosecute this action, Registrant also seeks an Order that in the event that document production, interrogatory responses and pretrial disclosures are not provided by a date certain, the Petition to Cancel shall be dismissed for Petitioner's failure to prosecute.

FACTS

Strike King filed its Petition to Cancel on December 3, 2010, almost a year and a half ago. According to the Petition, Strike King was the owner of U.S. Registration No. 2,464,463 for the mark ROCKET SHAD for fishing lures in Class 28, but it failed to file a Declaration of Continued Use under the Trademark Act, Section 8, and the mark was cancelled. Petition to Cancel ¶¶ 4-7. To correct the error, Petitioner filed U.S. Trademark Application No. 77/944,567 on February 25, 2010, for the ROCKET SHAD mark. *Id.* ¶ 8.

Registrant Wyman Von Mohr & Associates ("Registrant" or "Wyman") is the owner of U.S. Trademark Registration No. 3,500,147 for the mark ROCKET FISHING ROD for fishing rods in Class 28. *Id.* ¶ 17. The Trademark Examiner refused registration of Strike King's Application No. 77/944,567 in view of Wyman's registration; the Examiner concluded that there was a likelihood of confusion between the two marks. *Id.* ¶ 29.

Registrant filed an Answer to the Petition on January 12, 2011, alleging, *inter alia*, a lack of likelihood of confusion between the marks and, alternatively, that Registrant only uses its mark on a specific type of goods covered by the identification, *i.e.*, fishing rods for children and juniors, so that, at a minimum, Registrant would be entitled to a mark with a restricted identification.

Strike King sought a proposed settlement with Wyman, and the TTAB suspended this action *four times* at Strike King's request so as to allow the parties time to settle. During that time, Petitioner never provided Wyman a draft settlement agreement, despite attempts by Registrant's counsel, by both telephone and email, to obtain one. Ferrari Dec., ¶ 7.

When the matter eventually came off suspension and resumed pursuant to the Board's Order, Strike King still took no steps to settle or prosecute the action, neither providing a draft settlement agreement or serving Initial Disclosures, and never arranging a discovery conference or serving expert disclosures, discovery requests or pretrial disclosures.

At the close of discovery, on February 6, 2012, with no apparent prospect of settlement, Wyman served discovery, making Strike King's responses due March 12, 2012. No responses were forthcoming, and on March 26, 2012, Wyman wrote to Strike King, seeking document production and interrogatory responses, and noting the failure to serve pretrial disclosures (due March 22, 2012) as well. *See* Ferrari Dec., Exhibit C. On March 29, 2012, Strike King's counsel wrote a letter stating that his mother had had a health scare and that, after it was over, he learned that his case file for this matter had been "inadvertently boxed up and sent to . . . [the] firm's storage facility." Ferrari Dec., Exhibit D. Counsel did not indicate when discovery responses would be forthcoming, but said that he would be sending a draft settlement agreement and protective order that same day. Yet again, Wyman received nothing.

On April 2, 2012, Wyman wrote to Strike King, stating that it had not received the promised settlement agreement and protective order, nor had there been any representation as to when discovery responses would be forthcoming, and that it would make a motion to compel discovery if production and responses were not received by April 5, 2012. Registrant's counsel wrote that he was in the process of assembling documents for production, but by close of

business, nothing had been received by electronic delivery (which the parties had agreed to for service).

ARGUMENT

Strike King has failed to prosecute this action at every stage of the proceedings, not serving initial disclosures, expert disclosures, any discovery, or pretrial disclosures. Now, with Strike King having failed to timely respond to properly served discovery requests, Registrant seeks to compel the production of documents and responses, without objections, and to compel the service of Strike King's pretrial disclosures. Strike King should be ordered to respond by a date certain, failing which the Petition should be dismissed and judgment entered against Petitioner and in Wyman's favor.

Responses and objections to interrogatories and requests for the production of documents must be served within thirty days from the date of service, plus five extra days when served by mail. 37 C.F.R. § 2.120(a)(3); TBMP §§ 113.05, 403.03. Here, Registrant's discovery requests were served on February 6, 2012 (the last day of discovery), by U.S. Mail, thus making objections and responses due March 12, 2012.

A party which fails to respond to timely-served discovery and is unable to show that the failure was the result of excusable neglect may be found to have forfeited its right to object to the discovery on its merits. TBMP § 403.03. Here, Strike King has failed to respond to timely served discovery and cannot show an excusable failure. Although Strike King's counsel made reference to his mother's health emergency and his misplacing of the file, these excuses do not explain the extended delay in producing documents and taking all other steps to prosecute the action. *See Envirotech Corp. v. Compagnie Des Lampes*, 219 USPQ 448, 449 (TTAB 1979)

(excusable neglect not shown where counsel was out of the country and, upon return, failed to ascertain that responses were due).

Moreover, Registrant acted in good faith in attempting to resolve these issues before turning to the Board with a motion to compel, writing to Strike King twice to seek production. *E.g., MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952, 953 (TTAB 1979) (party seeking discovery required to make good faith effort to determine why no response has been made before coming to Board with motion to compel).

In sum, nearly a year and a half has passed without Petitioner prosecuting this proceeding in any meaningful way. Registrant has not been able to get basic discovery to defend itself against the potential cancellation of its trademark. As a result, Registrant's motion to compel discovery and the service of pretrial disclosures should be granted, and Petitioner should be deemed to have waived objections to the merits of the discovery. Moreover, in the event that Registrant fails to comply with an Order of the Board directing the production of, and responses to, discovery, by a date certain, the proceeding should be dismissed forthwith.

CONCLUSION

For the reasons set forth above, Registrant's motion to compel discovery and the service of pretrial disclosures should be granted, Registrant should be deemed to have waived all rights to object to the discovery requests on the merits, and Petitioner should be directed to produce all documents and information by a date certain, after which the proceeding should be dismissed and judgment entered in favor of Registrant.

Dated: April 5, 2012

/s/ Lisa A. Ferrari

Lisa A. Ferrari

Edward M. Weisz

COZEN O'CONNOR

277 Park Avenue

New York, New York 10172

Tel.: (212) 883-4900

Fax: (212) 986-0604

Attorneys for Registrant Wyman Von Mohr & Associates

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that on this day, a copy of the foregoing **MEMORANDUM OF LAW IN SUPPORT OF REGISTRANT'S MOTION TO COMPEL DISCOVERY AND PRETRIAL DISCLOSURES** is being electronically filed with the United States Patent and Trademark Office, Trademark Trial and Appeal Board at <http://estta.uspto.gov>.

/s/ Lisa A. Ferrari

CERTIFICATE OF SERVICE

I hereby certify that on this 5th day of April, 2012, a true and correct copy of the foregoing **MEMORANDUM OF LAW IN SUPPORT OF REGISTRANT'S MOTION TO COMPEL DISCOVERY AND PRETRIAL DISCLOSURES** was served by electronic delivery and by mailing a copy by First-Class, U.S. Mail to the following attorney of record:

Russell H. Walker, Esq.
Walker, McKenzie & Walker, P.C.
6363 Poplar Avenue, Suite 402
Memphis, Tennessee 38119-4896
rwalker@walkermckenzie.com

Attorneys for Petitioner Strike King Lure Company

/s/ Lisa A. Ferrari